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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,171	03/05/1999	LESLIE STROH	STROH	2689
545	7590	10/18/2005	EXAMINER	
ANTHONY H. HANDAL KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP 599 LEXINGTON AVENUE 33RD FLOOR NEW YORK, NY 10022-6030			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/264,171	STROH, LESLIE	
	Examiner	Art Unit	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-80 and 92-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 35-80 and 92-101 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Claims 35-80 and 92-101 are pending. Claims 35, 44-46, 48, 51-55, 58-60, 62, 64-66, 68-70, 72-76, 78, and 99-101 have been amended in this communication filed 08/05/05 entered as Response to Election/Restriction and Request for Extension of Time. Applicants' election with traverse of species 1A claim 35; 2A claim 38; 3A claim 41; 4B claim 45; 5A claim 46; 6A claim 50; 7I claim 61; 8A claim 62; 9A claim 64; 10G claim 74; 11A claim 75; and 12I claim 100 in the reply filed on 08/05/05 is acknowledged. The traversal is on the ground(s) that the election requirement is believed improper and reconsideration is respectfully requested.

Applicants' arguments have been carefully reconsidered and a new rejection is given here below. Applicants' arguments are further addressed in the "Response to Arguments" section here below.

2. As a preliminary matter, Applicants' are respectfully requested to submit the following references and all other non-patent references that have been submitted for consideration which are missing from the file:

In the Specification on page 25, lines 18-22; ***The League of Nations 1930/1931 convention on payments (Convention Providing a Uniform Law For Bills of Exchange and Promissory Notes, Geneva, 1930);***

On page 33, lines 25-28 and page 34, lines 1-4; the "UNITED NATIONS CONVENTION ON INTERNATIONAL BILLS OF EXCHANGE AND INTERNATIONAL PROMISSORY NOTES (UNCITRAL)";

On page 38, lines 23-28 and page 39, lines 1; **“ICC INCOTERMS1990 (ICC Publishing S.A., Paris, France”;** **“International Chamber of Commerce Universal Commercial Practices 500”;** **UNCITRAL Model Law on Bills of Exchange”;** and page 44, lines 27-28; the **“Vienna Convention on International Sale of Goods”;** and

On page 46, lines 10-13;**“ICC INCO TERMS 1990, ICC Publishing S.A. International Chamber of Commerce (Paris, France)”.**

***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 35-43 and 92-98, drawn to a method of providing an event-activated prerelease latent payment draft, classified in class 705, subclass 45.
  - II. Claims 44-67, 99, and 100, drawn to a method for providing an event-activated first bill-of-exchange, classified in class 705, subclass 1.
  - III. Claims 68-80 and 101, drawn to a computer-assisted trade finance method for financing the sale of a traded product, a computer-assisted method for trading a product, and a computer-implemented method for electronically facilitating a trade transaction including a pro-forma invoice identifying the buyer and the seller and having indicia indicating the traded product and the executed pro-forma invoice having information describing a commercial transaction, classified in class 705, subclass 37.
4. Inventions Group I, Group II and Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the

combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I has a method of providing an event-activated latent payment draft and Group II has a method for providing an event-activated first bill-of-exchange. The subcombination Group III has separate utility such as a computer-assisted trade finance method for financing the sale of a traded product, a computer-assisted method for trading a product, and a computer-implemented method for electronically facilitating a trade transaction including a pro-forma invoice identifying the buyer and the seller and having indicia indicating the traded product and the executed pro-forma invoice having information describing a commercial transaction.

In the instant case, invention Group I has separate utility such as the buyer providing an event –activated prerelease latent payment draft, the buyer accepting the payment draft, the buyer and seller commencing a payment term, and the seller releasing the traded product. Group I can be used in another environment such as in the shipping industry where the buyer is provided a prerelease bill of latent and the seller releasing the product(s). Invention Group II has separate utility such as providing an event-activated first bill-of exchange and the buyer accepting the first bill-of-exchange ordering payment and Group III has separate utility such as financing the sale of a traded product, trading a product, and electronically facilitating a trade transaction including a pro-forma invoice identifying the buyer and the seller and having indicia

indicating the traded product and the executed pro-forma invoice having information describing a commercial transaction. Group II can be used in another environment such as where a bill-of-exchange is used with the buyer accepting the conditions of the bill-of-exchange for the product or merchandise. Group III can be used in another environment such as buying and selling any product or merchandise where an invoice is used to request payment of the product(s) or merchandise or service(s). See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III and the search for Group II is not required for Group I and Group III, and the search for Group III is not required for Group I and Group II, restriction for examination purposes as indicated is proper:

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Response to Arguments***

9. Applicant's arguments filed 08/05/05 have been fully considered.

Issue no. 1: Applicant Argues: because of difficulties in understanding the election requirement, as explained previously, identification of every claim reading on a given "species" has not been found practicable and it is respectfully requested that this requirement also be withdrawn or be further explained so that Applicants' can comply with the same without undue difficulty has been considered. The Election of species has been withdrawn and a new clear restriction has been given. Applicants' are reminded to withdraw any claims in the non-elected invention whether the election be with or without traverse and a set of claims be submitted identifying the "withdrawn" or "previously amended" or "presently amended" or "cancelled" claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The Examiner can normally be reached on Tuesday-Thursday, 6:30 AM-5:00 PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**E. Colbert**  
**Primary Examiner**  
October 14, 2005